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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/833,593	04/13/2001	Martin Philip Usher	11696.0059	5641
27890	7590	09/25/2007	EXAMINER	
STEPTOE & JOHNSON LLP 1330 CONNECTICUT AVENUE, N.W. WASHINGTON, DC 20036			MILLER, BRANDON J	
			ART UNIT	PAPER NUMBER
			2617	
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			09/25/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/833,593	Applicant(s) USHER ET AL.	
	Examiner Brandon J. Miller	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-24 and 26-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13-24 is/are allowed.
- 6) ☒ Claim(s) 26-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 4/13/2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Introduction

1. In view of the Appellant's Brief filed on 06/12/2007, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned

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with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 13-24 and 26-36 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-37 of U.S. Patent No. 7,123,905 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because all of the claimed limitations of the present U.S. Application No. 09/833,593 are transparently found in U.S. Patent No. 7,123,905 B1 with obvious wording variations. For example:

Claim 31 of Patent No. 7,123,905 B1, which reads:

A method for forwarding incoming cellular communications to an aircraft, comprising: receiving a request to divert incoming calls for a cellular telephone number to a communication system on board an aircraft; Associating a divert on busy instruction with the cellular telephone number, the divert on busy instruction representing an instruction to forward an incoming call for the cellular telephone number to the communications system aboard the aircraft; considering a state of a cellular telephone associated with the cellular telephone number as busy, regardless of an actual state of the cellular telephone, and cellular telephone number is forwarded, consistent with said considering and in accordance with the diversion instruction, to the communications system on board the aircraft.

And claim 13 of the present application, which reads:

A method for forwarding incoming cellular communications to an aircraft, comprising:

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receiving a request to divert incoming calls for a cellular telephone number to a communication system on board an aircraft, the request including at least a temporary identification code representing a cellular telephone aboard the aircraft; associating a diversion instruction with the cellular telephone number, the diversion instruction representing an instruction to forward an incoming call for the cellular telephone number to the communications system aboard the aircraft; and considering a state of a cellular telephone associated with the cellular telephone number as busy, regardless of an actual state of the cellular telephone; wherein, an incoming telephone call to the cellular telephone number is forwarded, consistent with said considering and in accordance with the diversion instruction, to the communications system on board the aircraft.

Allowable Subject Matter

3. The following is an examiner's statement of reasons for allowance:

Claim 13 recites a method for forwarding incoming cellular communications to an aircraft with a structure as defined in the specification (pages 1-18) including receiving a request to divert incoming calls for a cellular telephone number to a communication system on board an aircraft, the request including at least a temporary identification code representing a cellular telephone aboard the aircraft; associating a diversion instruction with the cellular telephone number, the diversion instruction representing an instruction to forward an incoming call for the cellular telephone number to the communications system aboard the aircraft; and considering a state of a cellular telephone associated with the cellular telephone number as busy, regardless of an actual state of the cellular telephone; wherein, an incoming telephone call to the cellular

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telephone number is forwarded, consistent with said considering and in accordance with the diversion instruction, to the communications system on board the aircraft. Applicant's independent claim 13 comprises a particular combination of elements, which is neither taught nor suggested by the prior art.

Claims 14-18 are allowable based on their dependence of independent claim 13.

Claim 19 recites a method for routing incoming cellular telephone traffic through a land-based host network to a cellular device user aboard an aircraft, the cellular device user having an associated cellular telephone number, with a structure as defined in the specification (pages 1-18) including receiving, at the host network, a request to register the presence of the cellular device user aboard the aircraft, the request including at least a temporary identification code representing a cellular telephone aboard the aircraft; the host network advising the cellular device user's home network that the cellular device user is within the operating jurisdiction of the host network; associating, at the host network, a primary divert on busy instruction with the cellular telephone number, the divert on busy instruction representing an instruction to divert an incoming call to a communication system on board the aircraft; and considering a current operational state associated with the cellular telephone number as busy, regardless of an actual operational state of the cellular device; wherein, upon receipt of an incoming call to the cellular telephone number, the host forwards an incoming call to the communication system on board the aircraft consistent with the primary divert on busy instruction. Applicant's independent claim 19 comprises a particular combination of elements, which is neither taught nor suggested by the prior art.

Claims 20-24 are allowable based on their dependence of independent claim 19.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 26-28, and 31-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horrer (US 6,321,084 B1) in view of Lele et al. (US 6,185,433 B1).

Regarding claim 26 Horrer teaches a method of registering to divert a telephone call to a cellular telephone on-board a vehicle (see col. 2, lines 25-29 and 60-64). Horrer teaches receiving first and second identification information, the first identification information identifying the cellular telephone (See col. 2, lines 52-65 and col. 4, lines 57-63) and the second information representing a temporary identification code assigned to the cellular telephone device (see col. 2, lines 52-65 and col. 6, lines 14-22 & 44-50). Horrer does not specifically teach associating modified divert on busy instructions with the cellular telephone; and setting an indication of a status of the cellular telephone as busy regardless of an actual status of the cellular telephone. Horrer does teach associating diversion instructions associated with the cellular telephone (see col. 2, lines 25-29 and 25-29 and 52-65). Lele teaches considering a state of a telephone associated with a telephone number as busy, regardless of an actual state of the telephone (see col. 2, lines 14-20 and col. 3, lines 25-35). Lele teaches associating a busy operational mode with the mobile telephone (see col. 3, lines 25-35). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the call

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diversion device in Horrер adapt to include associating modified divert on busy instructions with the cellular telephone; and setting an indication of a status of the cellular telephone as busy regardless of an actual status of the cellular telephone because both references relate to methods for handling incoming calls and the combination would allow for Horrер to more efficiently divert incoming calls for mobile devices to terminals on-board a vehicle.

Regarding claim 27 Horrер teaches receiving a telephonic call intended for the cellular telephone (see col. 6, lines 38-42). Horrер teaches diverting the telephonic call to the cellular device on-board the vehicle (see col. 6, lines 38-42). Horrер does not specifically teach a modified divert on busy instruction. Lele teaches a modified divert on busy instruction (see col. 3, lines 25-35). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the device adapt to include a modified divert on busy instruction because both references relate to methods for handling incoming calls and the combination would allow for Horrер to more efficiently divert incoming calls for mobile devices to terminals on-board a vehicle.

Regarding claim 28 Horrер and Lele teach a device as recited in claim 26 except for receiving, associating and setting occur at a host network, the cellular device is associated with a home network different from the host network, and advising a home network that a cellular telephone is roaming within the coverage of a host network. Horrер does teach call diversion occurring at a host network, the cellular device is associated with a home network different from the host network (see col. 4, lines 44-56). Horrер does teach a host network communicating with a cellular device user's home network (see col. 4, lines 44-50). Horrер does teach a cellular device user that has moved within the operating jurisdiction of a host network (see col. 7, lines

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11-21). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the device adapt to include receiving, associating and setting occur at a host network, the cellular device is associated with a home network different from the host network, and advising a home network that a cellular telephone is roaming within the coverage of a host-network because this would allow for Horrer to more efficiently divert incoming calls for mobile devices to terminals on-board a vehicle.

Regarding claim 31 Horrer teaches a method for forwarding incoming telephone communications (see col. 2, lines 25-29 and 60-64). Horrer does not specifically teach considering a state of a telephone associated with a telephone number as busy, regardless of an actual state of the telephone and regardless of a source of an incoming telephone call; and during the considering, diverting the incoming call based on divert on busy instructions. Horrer does teach diverting an incoming call based on diversion instructions associated with the telephone number (see col. 2, lines 25-29 and 25-29 and 52-65). Lele teaches considering a state of a telephone associated with a telephone number as busy, regardless of an actual state of the telephone and regardless of a source of an incoming telephone call (see col. 2, lines 14-20 and col. 3, lines 25-35). Lele teaches during the considering, handling an incoming call based on busy operational mode (see col. 3, lines 25-35). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the device adapt to include considering a state of a telephone associated with a telephone number as busy, regardless of an actual state of the telephone and regardless of a source of an incoming telephone call; and during the considering, diverting the incoming call based on divert on busy instructions because both references relate to methods for handling incoming calls because both references relate to

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methods for handling incoming calls and the combination would allow for Horrер to more efficiently divert incoming calls for mobile devices to terminals on-board a vehicle.

Regarding claim 32 Horrер and Lele teach a device as recited in claim 31 except for receiving a request to divert incoming calls for the telephone number; and the considering is in response to the receiving. Lele does teach receiving a request to handle incoming calls in a busy operational mode for the telephone number (see col. 3, lines 25-32). Lele does teach the considering is in response to the receiving (see col. 2, lines 14-20 and col. 3, lines 25-35). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the device adapt to include receiving a request to divert incoming calls for the telephone number; and the considering is in response to the receiving because the combination would allow for Horrер to more efficiently divert incoming calls for mobile devices to terminals on-board a vehicle.

Regarding claim 33 Horrер teaches wherein a diversion request identifies one of a location, a communication system, or a telephone number that incoming calls are to be directed to (see col. 2, lines 25-29 and 25-29 and 52-65).

Regarding claim 34 Horrер and Lele teach a device as recited in claim 32 and is rejected given the same reasoning as above.

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5. Claims 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horrер (US 6,321,084 B1) in view of Martensson et al. (EP 0 494 525 A2).

Regarding claim 29 Horrер teaches a method of receiving a telephone call placed to a cellular telephone that is aboard a vehicle (see col. 6, lines 4-29). Horrер teaches receiving a call forwarded from a home network, the call being placed to the cellular telephone; and forwarding the call to the cellular telephone consistent with the accessing (see col. 2, lines 30-40). Horrер does not specifically teach returning a busy signal for a cellular telephone regardless of an actual state of the cellular telephone and accessing a divert-on-busy instruction for the cellular telephone. Horrер does teach diverting an incoming call based on diversion instructions for the cellular telephone (see col. 2, lines 25-29 and 52-65). Martensson teaches returning a busy signal for a cellular telephone regardless of an actual state of the cellular telephone (see col. 6, lines 5-9). Martensson teaches handling an incoming call based on "busy signal" instructions for the cellular telephone (see col. 6, lines 5-6). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the device adapt to include returning a busy signal for a cellular telephone regardless of an actual state of the cellular telephone and accessing a divert-on-busy instruction for the cellular telephone because both references relate to methods for handling incoming calls and the combination would allow for Horrер to more efficiently divert incoming calls for mobile devices to terminals on-board a vehicle.

Regarding claim 30 Horrер and Martensson teach a device as recited in claim 29 except for advising the home network that the cellular device is roaming on a host network. Horrер does teach a host network communicating with a cellular device user's home network (see col. 4, lines 44-50). Horrер does teach a cellular device user that has moved within the operating jurisdiction

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of a host network (see col. 7, lines 11-21). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the device adapt to include advising the home network that the cellular device is roaming on a host network because this would allow for Horrер to more efficiently divert incoming calls for mobile devices to terminals on-board a vehicle.

6. Claims 35-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horrер (US 6,321,084 B1) in view of Lele et al. (US 6,185,433 B1) and Kraft et al. (US 6,463,278 B2).

Regarding claim 35 Horrер and Lele teach a device as recited in claim 34 except for modifying any existing divert on busy instructions associated with the telephone number to accommodate the primary diversion instruction. Kraft teaches selecting one of a plurality of possible phone settings associated with the telephone to accommodate a first diversion instruction (see col. 2, lines 60-65, col. 3, lines 38-45, and TABLE 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the device adapt to include modifying any existing divert on busy instructions associated with the telephone number to accommodate the primary diversion instruction because this would allow for Horrер to more efficiently divert incoming calls for mobile devices to terminals on-board a vehicle.

Regarding claim 36 Horrер and Lele teach a device as recited in claim 34 except for the primary divert instruction supercedes any existing divert on busy instruction. Kraft teaches a first divert instruction that comes before the selection of any divert phone setting (see col. 2, lines 60-65, col. 3, lines 38-45, and TABLE 1). It would have been obvious to one of

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obvious skill in the art at the time the invention was made to make the device adapt to include the primary divert instruction supercedes any existing divert on busy instruction because this would allow for Horrер to more efficiently divert incoming calls for mobile devices to terminals on-board a vehicle.

Claim Objections

7. Claim 26 is objected to because of the following informalities: Claim 26 appears to contain grammatical errors in line 3-4. The limitation “the first identification information being identifying the cell telephone” is unclear. Appropriate correction is required.

Response to Arguments

8. Applicant's arguments with respect to claims 26-36 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brandon J. Miller whose telephone number is 571-272-7869. The examiner can normally be reached on Mon.-Fri. 8:00 am to 5:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on 571-272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



September 10, 2007



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